Hovsepian v. Apple, Inc.
Doc. 174 Att. 3

EXHIBIT 10

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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
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EXAMINER
SMITH,R

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
1300 I ST., NW
WASHINGTON, DC 20005-3315

ART UNIT	PAPER NUMBER
263	6

DATE MAILED: 08/29/91

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on ________ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice re Patent Drawing, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449. (2 sheets)
4. ☐ Notice of Informal Patent Application, Form PTO-152
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ ________.

Part II SUMMARY OF ACTION

1. ☒ Claims 1 - 32 are pending in the application.

   Of the above, claims ________ are withdrawn from consideration.

2. ☐ Claims ________ have been cancelled.
3. ☐ Claims ________ are allowed.
4. ☒ Claims 1-9, 12-27 and 29-32 are rejected.
5. ☒ Claims 10, 11 and 28 are objected to.
6. ☐ Claims ________ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on ________. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on ________. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed ________, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. ________ ; filed on ________.

1. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

2. Claims 10 and 11 are objected to under 37 C.F.R. § 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in alternative only. See M.P.E.P. § 608.01(n). Accordingly, these claims have not been further treated on the merits.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-6, 8, 9, and 12-17, 22-27 and 29-32 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lang.

Lang discloses a video/audio storage system which is capable of providing information to remote locations. See Fig. 2 for library means (11), compression means (26), data storing means (13) and transmitting means (18). See column 4, lines 28-31 for the identification coding, lines 32-41 for the conversion, lines 41-54 for the ordering into designated array of pixels, and line 63 to column 5, line 8 for the compression. Further note column 7, lines 45-66 and column 10, lines 8-20, for transmission to a remote location.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 7 and 18-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Lang in view of Fenwick et al.

Lang differs from applicant's claims 18-21 in he does not provide any particulars for his system being able to distribute audio and video information (specifically, the requesting of the information at a remote location). This is clearly shown in Fenwick et al. to be a fundamental step necessary in a distribution system. Therefore, it would have been obvious for one of ordinary skill in the art to include a step of requesting by a remote location in Lang so one would known when to transmit the information. Also note Fig. 8B in Fenwick et al for showing a list is necessary when a plurality of choices of information to be received by a user are available (claim 21).

6. Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Smith whose telephone number is (703) 308-0487.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0962.

Douglas W. Olms

DOUGLAS W. OLMS
SUPERVISORY PATENT EXAMINER
ART UNIT 263

R.S.

R. Smith:St
August 02, 1991